UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. VAN TASSEL, DAVID R. HOLMES,
and ROBERT S. SCHWARTZ

Appeal No. 2006-1805
Application No. 09/382,275

HEARD: July 13,, 2006

Before FRANKFORT, OWENS, and CRAWFORD, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from a rejection of claims 1, 2, 30, 43-45, 58-64, 73 and 82-87. Claims 3-29, 31-42, 46-57, 65-72 and 76-81, which are all of the other pending claims, have been withdrawn from consideration by the examiner.

THE INVENTION

The appellants claim 1) an implantable stent having a tubular body with interconnected microholes distributed substantially uniformly along its entire length, and 2) a method for using the stent to treat a tubular body organ. Claim 1, which claims the stent, is illustrative:

1. An implantable stent comprising a tubular stent body having a plurality of interconnected microholes distributed throughout said stent body substantially uniformally along the entire length of said stent body, said plurality of microholes being sufficiently small so as to promote an organized growth pattern of infiltrating cells throughout said stent body, and said stent body being otherwise substantially free of holes larger than said microholes.

THE REJECTION

Claims 1, 2, 30, 43-45, 58-64, 73 and 82-87 stand rejected under 35 U.S.C. 112, first paragraph, written description requirement.

OPINION

We reverse the aforementioned rejection.

The examiner argues (answer, page 3):

> In regard to claim[s] 1 and 58, the limitation the "stent body being otherwise substantially free of holes larger than said microholes" is considers [sic] new matter. Applicant's embodiment as depicted in Figure 1 includes a substantial numbers [sic] of diamond shaped holes, which are larger than the microholes, and the original disclosure lacks any description of an embodiment, which is substantially free of the holes larger than the microholes.

The appellants' specification discloses that the stent preferably is made of expandable metal or braided wire (page 18, lines 1-8). The stent in the appellants' figure 1 appears to be made of such a material. The appellants' argument is consistent with that interpretation of figure 1 (reply brief, page 2). After disclosing, at the end of the discussion of figure 1, that the stent preferably is made of expandable metal or braided

wire, the appellants' specification discloses that the stent "may also be fabricated from a composition of metallic fibers, uniformly laid to form a three-dimensional, non-woven structure, such as is shown in Figure 2" (page 18, lines 3-4).

The examiner argues that "Figure 2 does not illustrate a whole stent is made from metallic fibers that forms [sic] microholes and excluding holes larger than the microholes but figure 2 only depicted in the drawing and described in the specification to show part of what a stent, such as a strut of a stent (14) in figure 1, my [sic] look like when it is enlarged" (answer, pages 4-5). The above-mentioned disclosure, at the end of the discussion of figure 1, that the stent preferably is made of expandable metal or braided wire, but may also be made from uniformly laid metallic fibers as shown in figure 2, indicates that the stent in figure 1 is made of expandable metal or braided wire, whereas the portion of a stent in figure 2 is uniformly laid metallic fibers. The specification does not provide support for the examiner's argument that figure 2 shows an enlarged part of the stent having diamond shaped holes in figure 1.

Moreover, the appellants' specification discloses that a material having the desired properties of the stent made of uniformly laid metallic fibers is Bekipor® filter medium

(page 15, lines 15-18). There is no indication in the record that holes larger than microholes would be desirable in either a filter medium or the appellants' stent made of uniformly laid metallic fibers wherein the microholes are sized to promote the organization of ingrowing cells (specification, page 6, lines 7-10).

For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of lack of compliance with the 35 U.S.C. § 112, first paragraph, written description requirement.

DECISION

The rejection of claims 1, 2, 30, 43-45, 58-64, 73 and 82-87 under 35 U.S.C. 112, first paragraph, written description requirement, is reversed.

REVERSED

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Administrative Patent Judge)
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